

### REMARKS

#### Claim Amendments:

Claims 31, 34, 36, 38, 40, 42 and 44 have been canceled. Claims 29, 35, 37, 39, 41 and 43 have been amended.

Claim 29 has been amended to recite that no more than 11 of the total 12 hydrogen atoms of  $R^1$  and  $R^2$  may be deuterium and that when all 6 hydrogen atoms of  $R^2$  are deuterium, at least one hydrogen atom of  $R^1$  is deuterium. Claims 35, 37, 39, 41 and 43 have been amended to recite that no more than 5 of the total 6 hydrogen atoms of the methyl groups in the 2 and 6 positions may be deuterium.

No new matter has been added by these amendments. The Examiner is hereby requested to enter these amendments.

#### Rejection under 35 U.S.C. §112:

The Examiner's rejection of claims 29-34 under 35 U.S.C. §112, second paragraph, as allegedly indefinite is respectfully traversed. Claim 29 has been amended to recite that no more than 11 of the total 12 hydrogen atoms of  $R^1$  and  $R^2$  may be deuterium and that when all 6 hydrogen atoms of  $R^2$  are deuterium, at least one hydrogen atom of  $R^1$  is deuterium. Accordingly, Applicants submit that the claims are not indefinite.

Withdrawal of the rejection is requested.

#### Rejection under 35 U.S.C. §102:

The Examiner's rejection of Claims 35-44 under 35 U.S.C. §102 as anticipated by Rampe (Eur. J. Med. Chem., 1993) is respectfully traversed. Claims 35, 37, 39, 41 and 43 have been amended to recite that no more than 5 of the total 6 hydrogen atoms of the methyl groups in the 2 and 6 positions may be deuterium. In order to anticipate, a reference must disclose each and every element of the claimed invention. Rampe does not disclose deuterated compounds having only 5 of the 6 hydrogen atoms of the methyl groups at the 2 and 6 positions replaced with deuterium atoms. Accordingly, Rampe does not anticipate the claimed invention.

Withdrawal of the rejection is requested.

Rejection under 35 U.S.C. §103:

The Examiner's rejection of Claims 29-30, 32, 33 and 35-44 under 35 U.S.C. §103(a) as unpatentable over Rampe (Eur. J. Med. Chem., 1993) in view of Funaki (Biochem. Pharm., 1989) in further view of Liepins (USP 5,223,269) is respectfully traversed.

To properly issue an obvious rejection under 35 U.S.C. §103, the USPTO bears the initial burden of establishing a prima facie case of obviousness by meeting three criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings to arrive at the claimed invention. In re Vaeck, 20 USPQ 2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. Id. Finally, the prior art reference or the combination of references must teach or suggest all the claim limitations. In re Royka, 180 USPQ 580 (CCPA 1974).

In the present case, Rampe fails to teach or suggest the claimed invention, as discussed above. In particular, Rampe does not teach that when all 6 hydrogen atoms of R<sup>2</sup> are D atoms, at least one H atom in the CH<sub>3</sub> groups of R<sup>1</sup> is D atoms. While Funaki does show that the deuterium substitutions may be at positions other than the 2 and 6 methyl groups, Funaki shows only substitution of *all* hydrogens with deuterium. In contrast, in the claimed invention not all the hydrogens are substituted with deuterium atoms. Liepins does not cure this deficiency. In fact, Liepins does not mention nifedipine or nicardipine at all, nor does Liepins teach or suggest the deuterium substitution set forth in the claimed invention.

Using the method of Rampe, one would not obtain the claimed compounds, i.e., those with less than total deuterium substitution. Neither Funaki nor Liepins provide any teaching or suggestion that would lead to the claimed invention, since all the compounds of Funaki have fully deuterated methyl groups and Liepins does not teach or suggest the use of the claimed compounds at all.

Withdrawal of the rejection is requested.

Double Patenting Rejections:

The Examiner's rejection of Claims 31 and 34 under 35 U.S.C. §101 as claiming the same invention as that of Claims 3 and 4 of U.S. Patent No. 5,846,514 is respectfully traversed in view of the cancellation of these claims.

The Examiner's rejection of Claims 29-30, 32, 33 and 35-44 under the judicially created doctrine of obviousness type double patenting as unpatentable over claims 1-10 of U.S. Patent No. 5,846,514 is respectfully traversed in view of the Terminal Disclaimer filed herewith.

Withdrawal of the rejections is hereby requested.

Conclusions:

For the reasons set forth above, Applicants submit that the claims of this application are patentable. Reconsideration and withdrawal of the Examiner's rejections are respectfully requested. Allowance of the claims of this application at an early date is earnestly solicited.

Enclosed is a \$55.00 check for the fee required under 37 C.F.R. §1.20(d) and a \$55.00 check for a one month extension of time. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: November 6, 2003

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